REMARKS

Pending claims

Original claims 1-20 are currently pending in the present application, original claims 21-31 having been canceled in paragraph 3 at page 1 of Applicants' "Request for Filing a Patent Application Under 37 CFR 1.53(b)" submitted with the application at the time of filing.

THE FOLLOWING LISTING OF THE GROUPS IS OPTIONAL:

Restriction Requirement

Applicants hereby elect, with traverse, to prosecute Group III, which includes and is drawn to claims 1 and 5, which claims are drawn to, respectively, an isolated polypeptide comprising an amino acid sequence of SEQ ID NO:1; and a composition comprising an effective amount of a polypeptide of claim 1 and acceptable excipient. The Restriction Requirement is traversed for at least the following reasons.

Applicants submit that the invention encompassed by the claims of Group I (claims 10 and 11) and Group IV (claims 16-18 and 20), drawn to nucleic acids and antibodies, respectively, could be examined at the same time as the invention encompassed by the claims of Group III without undue burden on the Examiner. For example, a search of the prior art to determine the novelty of the polypeptides of Group III would provide information regarding the novelty of the polynucleotides and the antibodies of Groups I and IV.

Applicants further submit that claim 2 (Group II) is a method of making the polypeptides of Group III, and claims 6-9 (Groups VI-VIII) are methods of using the polypeptides of Group III, which should be examined together with the polypeptides of Group III, per the Commissioner's Notice in the Official Gazette of March 26, 1996, entitled "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai, In re Brouwer* and 35 U.S.C. § 103(b)" which sets forth the rules, upon allowance of product claims, for rejoinder of process claims covering the same scope of products.

Applicants further traverse on the grounds that the Examiner could also examine the claims of Group I (claims 10 and 11) without undue burden, in view of the fact that they are related to, although of different scope from, claims already allowed in the parent application. In particular, the claims of Group I are drawn, respectively, to an isolated polynucleotide encoding a polypeptide of claim 1, or the

complement thereof; and to an isolated polynucleotide sequence comprising SEQ ID NO:2, or the complement thereof.

For the Examiner's convenience, the claims issued in the parent application are as follows:

U. S. Patent No. 6,714,985:

1. An isolated and purified polynucleotide encoding a polypeptide comprising the amino acid sequence of SEO ID NO: 1.

2. A composition comprising the polynucleotide of claim 1.

3. An isolated and purified polynucleotide which is completely complementary to the entire length of the polynucleotide of claim 1.

4. An isolated and purified polynucleotide comprising SEQ ID NO:2.

5. An isolated and purified polynucleotide which is completely complementary to the entire length of the polynucleotide of claim 4.

6. An expression vector comprising the polynucleotide of claim 1.

7. A host cell containing the expression vector of claim 6.

Applicants additionally submit that in any case, there is minimal additional burden on the Examiner to examine the claims of Groups I in addition to the claims of Group III, particularly in view of the additional burden on Applicants to file, prosecute and maintain yet additional applications in this family, and respectfully request that the Examiner consider doing so.

Accordingly, because the search required to identify prior art relevant to the claims of Groups I and III would substantially overlap, Applicants respectfully submit that examination of the claims included in those groups, would pose no undue burden. Thus, Applicants request reconsideration and withdrawal of the Restriction Requirement and examination of the claims of Group III (claims 1 and 5), and Group I (10, 11)

Applicants reserve the right to prosecute the subject matter of non-elected claims, or of any subject matter disclosed but not herein claimed, in a later continuation or divisional application.

It is noted that, while Applicants have canceled and not repeated new versions of original claims 21-31, Applicants expressly assert that these claims have been canceled for reasons relating to cost and efficiency of prosecution of the presently elected claims, and not for reasons relating to

patentability. Applicants further expressly reserve the right to pursue the subject matter of those canceled claims, or any other subject matter disclosed but not herein claimed, in a later continuation or divisional application.

Applicants believe that no fee is due with this communication. However, if the USPTO determines that a fee is due, the Commissioner is hereby authorized to charge Deposit Account No. 09-0108.

Respectfully submitted,
INCYTE GENOMICS, INC.

Date: 4 November 2002

Cathleen M. Rocco, M.S., J.D.
Reg. No. 46,172
Direct Dial Telephone: (650) 845-4587

3160 Porter Drive
Palo Alto, California 94304
Phone: (650) 855-0555
Fax: (650) 849-8886

Docket No.: PF-0385-1 DIV

VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE SPECIFICATION:

The paragraph beginning at the top of page 1, wherein priority is claimed under 35 U.S.C. § 120 to the parent application, has been amended as follows:

This application is a divisional application of U.S. application Serial No. 08/928,442, filed September 12, 1997, now U.S. Patent Serial Number 6,214, 985, issued April 10, 2001, entitled "AUTOANTIGEN-LIKE PROTEIN," all of which applications and patents are hereby incorporated herein by reference.